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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,444	02/15/2002	Richard Brown	30006610-2	8754

7590 05/13/2005

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EXAMINER	
AVELLINO, JOSEPH E	
ART UNIT	**PAPER NUMBER**
2143	

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/075,444	BROWN ET AL.	
	Examiner	Art Unit	
	Joseph E. Avellino	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) *13-27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/10/02, 3/18/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *IDS dated 12/15/03*.

DETAILED ACTION

1. Claims 1-27 are presented for examination; claims 1, 8, 13, and 21 independent. In response to the Restriction, dated March 10, 2005, Applicant has elected with traverse Group I, claims 1-12; claims 1 and 8 independent. Claims 13-27 are hereby withdrawn from examination as being drawn to a nonelected invention.

Priority

2. Applicant's claim to priority under 35 USC 119 has been acknowledged.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-12 are rejected under 35 U.S.C. 101 because the claimed invention is not tangibly embodied. Independent claim 8 recites an email handling *apparatus* however comprises only an email *agent* which as defined in the specification on page 8, lines 8-11 is an application or service, which is not a tangible embodiment. Correction is required. Claims 9-11 are rejected as being dependent upon rejected independent claim 8.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 8 recites an apparatus however does not claim any part of an apparatus, merely non-tangible embodiments of the invention (i.e. an email agent). Correction is required

Claims 9-12 are rejected as being dependent upon rejected independent claim 8.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-10, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Tarbotton et al. (USPN 6,757,830) (hereinafter Tarbotton).

8. Referring to claim 1, Tarbotton discloses an email handling method, comprising the step of storing an email in a compartment (i.e. dirty mail store 16) of a compartmented operating system (i.e. AV sys) (Figure 2; col. 5, lines 60-65).

9. Referring to claim 2, Tarbotton discloses storing an email in a compartment with other emails (it is inherent that this feature is included in Tarbotton since all emails are included in the dirty mail store).

10. Referring to claim 3, Tarbotton discloses storing the email in an individual compartment (i.e. an individual compartment of the antivirus system known as the dirty mail store 16, it is not stored in any other compartments such as AV sys rules 22, scan engine 18, or virus definition data 20) (Figure 2; ref. 16).

11. Referring to claim 4, Tarbotton discloses assessing the email according to a security policy (i.e. holding the email for a set amount of time based on the characteristics of the email) (Figure 3; ref. 32, 34, 38).

12. Referring to claim 5, Tarbotton discloses determining a security status for the email (i.e. determine mail latency delay) (Figure 3, ref. 32; col. 7, lines 13-45).

13. Claims 7-10, and 12 are rejected for similar reasons as stated above.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Tarbotton.

16. Referring to claim 6, Tarbotton discloses the invention substantively as described in claims 1 and 8. Tarbotton does not specifically state applying a security tag to the email denoting the security status, however does disclose that anti-virus or anti-spam actions are taken, which can comprise disinfecting, blocking, deleting, etc. (col. 6, lines 44-55). In order to determine if an email has already been scanned and the results of

said scan, one of ordinary skill would understand it would be obvious to modify the teaching of Tarbotton to include a security tag. By this rationale, "Official Notice" is taken that both the concept and advantages of providing for a security tag to an email denoting the security status is well known and advantageous in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Tarbotton to include a security tag denoting the security status in order to easily determine if the email poses a security threat and what to do if it contains matter hazardous to the network, thereby reducing overall complexity of the system and allowing for future upgrades and replacements to be easily accomplished.

17. Claim 11 is rejected for similar reasons as stated above.

Response to Arguments

18. Applicant's arguments filed March 30, 2005 have been fully considered but they are not persuasive.

19. Applicant argues, in substance, that (1) restriction is improper since class 713 does not disclose anything about email.

20. As to point (1) Applicant can look at Tarbotton to find applications which require search of class 713 which include email. Class 709/206 is designed for the actual *transmission* of emails, Applicant's invention is drawn to an email handling system

which is merely storing and viewing these emails, which are considered two separate functions. While Applicants inventions may require searches of the same subject matter, it is believed that the searches are not coextensive (i.e. searching for Group I does not require art teaching navigating to a compartment via a browser and opening an email using the browser. By this rationale the restriction is proper.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

22. Thomlinson et al. (USPN 6,272,631) disclose protected storage of core data secrets.

23. Milliken et al. (US 2004/0073617) discloses hash-based detecting and preventing transmission of unwanted email.

24. Reed et al. (USPN 5,903,732) discloses trusted gateway agent for web server programs.

25. It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art. As it is Applicant's right to continue to claim as broadly as possible their invention. It is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality (i.e. defining what Applicant means by a compartmented

operating system as well as how the data is stored and what happens when it is stored) that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique

26. Applicant employs broad language, which includes the use of word, and phrases, which have broad meanings in the art. As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993). Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly, define the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEA
April 21, 2005

DAVID WILEY
SUPERVISORY PATENT EXAMINER
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